REMARKS

The Office Action dated March 17, 2009 has been received and carefully noted. The following remarks, are submitted as a full and complete response thereto.

Claims 1-41 are presently pending in the application and are submitted for reconsideration. No new matter has been added and no new issues are raised requiring additional consideration or search.

As an initial matter, Applicants submit that all of the Applicants arguments have not been addressed and the Office Action is incomplete. Chapter 7, §707.07(f) of the MPEP provides that "In order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application. Where the requirements are traversed, or suspension thereof requested, the examiner should make proper reference thereto in his or her action on the amendment. <u>Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.</u>" In the Office Action dated March 17, 2009, there is no indication that the rejection of claims 38 and 39 under 35 U.S.C. §101, or, under 35 U.S.C. §112, first paragraph, has been considered. Applicants provided detailed reasons why both rejections must be withdrawn. However, the substance of such arguments has not been addressed. Accordingly, the finality of this Office Action is improper and must be withdrawn. Applicants respectfully request that

the next Office Action address all of the arguments submitted on pages 19-21 of the Response dated December 18, 2008, which are also repeated below for convenience.

The Office Action rejected claims 38 and 39 under §101 for allegedly being directed to non-statutory subject matter. The rejection alleged that the computer readable medium is not defined in the specification. The rejection also alleged that claims 38 and 39 will be considered non-statutory subject matter absent support in the specification. This rejection is respectfully traversed.

What is disclosed in the specification has no bearing on patentability under the statutory classes of invention governed by 35 U.S.C. §101. Furthermore, "A computer readable medium" is statutory subject matter under U.S. patent laws. Support for the definition of a computer readable medium is provided by *In re Lowry*, 32 F.3d 1579, 1583-1854, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994), which states:

> "When functional descriptive material is <u>recorded on some computer-readable medium,</u> it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized" (see §2106.01 of the MPEP).

As can be clearly observed from the court's decision in *Lowry* a computer readable medium is statutory subject matter under §101. By having software recorded on a computer readable medium, it becomes structural and functional with respect to that medium, and, thus, statutory subject matter. Withdrawal of the rejection is kindly requested.

In the Office Action, claims 38 and 39 were rejected under §112, first paragraph, because the computer readable medium is not defined in the specification and is, thus, non-statutory subject matter absent support in the specification. This rejection is respectfully traversed. Referring the Examiner to FIG. 4 of the present application, a process is illustrated which defines a new event package for event registrations of a user to be implemented by a registrar and used by a presence server 303. The user may be a computer terminal 123 or laptop 112 which may include a computer readable medium (see lines 23-33 of page 7 of the specification). A computer readable medium may be regarded as a computer memory which a computer terminal 123 or laptop 112 is certain to include. Or, one of ordinary skill in the art is certain to conclude that a computer terminal 123 or laptop 112 includes a computer readable medium in order to carry out the functions of such a computing device.

As for the presence server 303, the presence server interfaces with the shared resource 204 which provides storage for the presence information (see last 3 lines of page 9 of the specification). The presence server 303 also may be a computer readable medium because it also has a memory. Among the various operations performed in claims 38 and 39, each of these operations is performed with reference to the computer readable mediums provided by the presence server and/or the user. Therefore, the specification provides support for a computer readable medium, and claims 38 and 39 are in compliance with §112, first paragraph. Withdrawal of the rejection is kindly requested.

Claims 1-6, 11-23, 25-29 and 34-41 were rejected under 35 U.S.C. §103(a) as being unpatentable over Bobde (U.S. Patent Publication No. 2003/0217142) in view of Holt (U.S. Patent Publication No. 2008/0244026). The Office Action took the position that Bobde discloses all of the elements of the claims, with the exception of sending a message for an event from a second network element to a first network element, wherein the event is a change in registration information of at least one of the plurality of users at the first network element. The Office Action then cited Holt as allegedly curing this deficiency in Bobde. This rejection is respectfully traversed for at least the following reasons.

Claim 1, upon which claims 2-10 are dependent, recites a method that includes maintaining, in a first network element of a communication system, registration information from a plurality of users. The method also includes maintaining, in a second network element of the communication system, information associated with said plurality of users. The second network element information comprising a record of registration information that is separate from the registration maintained in the first network element. The second network element is separate from the first network element. The second network element information is dependent on the registration information. The method also includes sending a subscribe message for an event from the second network element to the first network element. The event is a change in the registration information of at least one of the plurality of users at the first network element. The method also includes receiving at the first network element a register message from at least one user, the

message changing the registration information of said at least one user. The method also includes sending a notification from the first network element to the second network element in response to the register message. The notification includes information associated with said at least one user. The information associated with said at least one user comprising registration status information of a network device operated by said user.

Claim 11, upon which claims 12-16 are dependent, recites a system that includes a first network element configured to maintain registration information from a plurality of users. The system also includes a second network element configured to maintain information associated with the plurality of users. The second network element information comprising a record of registration information that is separate from the registration maintained in the first network element. The second network element is separate from the first network element. The second network element information is dependent on the registration information. The second network element is configured to send a subscribe message for an event to the first network element. The first network element is configured to receive a register message from at least one user, said register message configured to change the registration information of said at least one user. The event is associated with a change in the registration information of at least one of the plurality of users at the first network element. The first network element is configured to send a notification from the first network element to the second network element in response to the register message. The notification includes information associated with

said at least one user. The information associated with said at least one user comprising registration status information of a network device operated by said user.

Claim 17, upon which claims 19-23 are dependent, recites an apparatus that includes storage circuitry configured to maintain registration information from a plurality of users. The apparatus also includes receiving circuitry configured to receive a subscribe message for an event from a network element. The network element maintaining information comprising a record of registration information that is separate from the registration maintained in the apparatus and said network element information is dependent on the registration information. The network element is separate from the apparatus and the event is associated with a change in the registration information of at least one of the plurality of users at the apparatus. The apparatus also includes receiving circuitry configured to receive a register message from at least one user. The register message configured to change the registration information of said at least one user. The apparatus also includes transmitting circuitry configured to send a notification to the network element in response to the register message. The notification includes information associated with said at least one user, the information associated with the at least one user comprising registration status information of a network device operated by said user.

Claim 18, upon which claims 25-33 are dependent, recites an apparatus that includes storage circuitry configured to maintain information associated with a plurality of users. The information is dependent on registration information maintained at a

network element. The network element is separate from the apparatus. The apparatus also includes transmitting circuitry configured to send a subscribe message for an event to the network element. The network element maintaining information comprising a record of registration information that is separate from the registration maintained in the apparatus and the network element information is dependent on the registration information. The event is associated with a change in the registration information of at least one of the plurality of users at the network element. The apparatus also includes receiving circuitry configured to receive a notification from the network element. The notification includes information associated with the at least one user. The information associated with the at least one user comprising registration status information of a network device operated by said user.

Claim 34 recites a method that includes maintaining, in a registrar server network element of a communication system, registration information from a plurality of users. The method also includes maintaining, in a presence server network element of the communication system separate from the registrar server network element, information associated with said plurality of users. The presence network element information comprising a record of registration information that is separate from the registration maintained in the registrar network element wherein the presence server network element information is dependent on the registration information. The method also includes sending a subscribe message for an event from the presence server network element to the registrar server network element. The event is a change in the registration

information of at least one of the plurality of users at the registrar server network element. The method also includes receiving at the registrar server network element a register message from at least one user, the message changing the registration information of said at least one user. The method also includes sending a notification from the registrar server network element to the presence server network element in response to the register message. The notification includes information associated with the at least one user. The information associated with the at least one user comprising registration status information of a network device operated by said user.

Claim 35 recites a system that includes a registrar server network element configured to maintain registration information from a plurality of users. The system also includes a presence server network element configured to maintain information associated with said plurality of users. The presence network element information comprising a record of registration information that is separate from the registration maintained in the registrar network element. The presence server network element is separate from the registrar service network element and the presence server network element information is dependent on the registration information. The presence server network element is configured to send a subscribe message for an event to the registrar server network element. The registrar server network element is configured to receive a register message from at least one user, said register message configured to change the registration information of said at least one user. The event is associated with a change in the registration information of at least one of the plurality of users at the registrar server

network element. The registrar server network element is configured to send a notification from the registrar server network element to the presence server network element in response to the register message. The notification includes information associated with the at least one user. The information associated with the at least one user comprising registration status information of a network device operated by the user.

Claim 36 recites an apparatus that includes storage circuitry configured to maintain registration information from a plurality of users. The apparatus also includes receiving circuitry configured to receive a subscribe message for an event from a presence server network element. The presence server network element maintaining information comprising a record of registration information that is separate from the registration maintained in the apparatus. The network element information is dependent on the registration information. The presence server network element is separate from the apparatus. The event is associated with a change in the registration information of at least one of the plurality of users at the apparatus. The apparatus also includes receiving circuitry configured to receive a register message from at least one user. The register message configured to change the registration information of the at least one user. The transmitting circuitry is configured to send a notification to the presence server network element in response to the register message. The notification includes information associated with the at least one user. The information associated with the at least one user including registration status information of a network device operated by said user.

Claim 37 recites an apparatus that includes storage circuitry configured to maintain information associated with a plurality of users. The information is dependent on registration information maintained at a registrar server network element. The registrar server network element is separate from the apparatus. The apparatus also includes transmitting circuitry configured to send a subscribe message for an event to the registrar server network element. The presence server network element maintaining information comprising a record of registration information that is separate from the registration maintained in the apparatus and the network element information is dependent on the registration information. The event is associated with a change in the registration information of at least one of the plurality of users at the registrar server network element. The apparatus also includes receiving circuitry configured to receive a notification from the registrar server network element. The notification includes information associated with the at least one user. The information associated with the at least one user including registration status information of a network device operated by the user.

Claims 38 and 39 recite computer program type claims that are similar to the operations of the above-noted method claims. Claims 40 and 41 are means-plus-function claims that are similar to the elements recited in the above-noted apparatus claims. However, claims 38-41 each have their own scope.

As will be discussed below, the combination of Bobde and Holt fails to disclose or suggest all of the elements of the claims, and therefore fails to provide the features discussed above. The rejection is respectfully traversed for at least the following reasons.

Bobde discloses a method and system for supporting the communication of presence information regarding one or more telephony devices. More specifically, Bobde discusses a system for detecting and communicating the presence of one or more computing devices. Bobde also discusses a method and system for aggregating presence information generated by multiple devices associated with a single user. Bobde describes a single server acting as a presence agent and a registration agent.

Bobde also discloses a single server 102 acting as both a presence agent and a registration agent. Referring to FIG. 3 of Bobde, the server 102 includes a registration program 154 and a presence agent 152 as part of the server 102. In other words, Bobde describes a single network element (i.e., server 102) upon which a first presence application can be run and a second registration agent can also be run. Both agents have access to the same information source of the server 102.

Bobde fails to disclose "maintaining, in a first network element...registration information from a plurality of users...maintaining, in a second network element...information associated with said plurality of users, said second network element information comprising a record of registration information that is separate from the registration maintained in the first network element, wherein the second network element is separate from the first network element...and...said information associated

with said at least one user comprising registration status information of a network device operated by said user", as recited, in part, in independent claim 1 and similarly in independent claims 11, 17, 18 and 34-41.

The independent claims each recite two separate network elements (e.g., a first network element and a second network element, or, a presence server and a registrar server). The claims also recite that there are two "separate" pieces of registration information. Bobde illustrates a single registration application "R" used by the entire server 102. Although, in Bobde, the presence agent 152 is illustrated as being in direct communication with the registration application 154, whatever registration information is used by the presence agent 152 or any other part of the server 102, that information is certainly only stored in the registration application 154. In other words, there is no second "separate" registration information provided anywhere.

In addition to the above-noted deficiencies of Bobde, the type of system illustrated in Bobde is similar to the type of system that is disclosed in the specification as being prior art (see FIG. 2 of the present application). Referring to FIG. 2, the single network entity 206 includes a registrar 203 and a presence server 205 in the same network element. FIG. 3 of the present application illustrates two separate network entities 301 and 303, which include the registrar 302 and the presence server 304. The independent claims clearly recite that there are two separate network entities similar to FIG. 3. Bobde does not disclose two separate network entities that both keep records of registration

related information. In addition to the above-noted deficiencies of Bobde, Holt further fails to cure those deficiencies.

Holt discloses a system for providing presence and availability status information from a first user to a second user. The system includes a presence availability server for storing presence and availability status information. The presence availability server detects a change in presence status and/or availability of the first user, and informs a notification server of the change in status of the first user. In turn, the notification server sends the status change information of the first user to the second user.

The Office Action alleged that Holt discloses sending a subscribe message for an event from the second network element to the first network element (see paragraphs [0019] and [0025] of Holt). Referring to FIG. 1 in Holt, it appears that the Office Action has relied on the signaling from the presence availability server (i.e., second network element) to notification server (i.e., first network element) as allegedly disclosing the features recited in claim 1. According to Holt, the presence availability server sends a change in the presence status of a user to a notification server. Contrary to the example disclosed in Holt, in the present patent application, registrar server (i.e., first network element) maintains the registration information of the user and the presence server (i.e., second network element). In addition, the presence server subscribes to the registrar server to obtain changes in presence and registration status of the user. The registrar server (i.e., first network element) would then notify presence server (i.e., second network element) of any changes in the presence status of the user.

Claim 1 of the present application recites "sending a subscribe message for an event from the second network element to the first network element, wherein the event is a change in the registration information of at least one of the plurality of users...receiving at the first network element a register message from at least one user, said message changing the registration information of said at least one user...sending a notification from the first network element to the second network element in response to the register message." In the present application, the registrar server maintains the user registration information and the presence server subscribes to the registrar server for the changes in presence status of the user. In addition, the registrar server sends a notification to the presence server when changes occur.

In Holt, there is no registrar server as described in the present patent application. Holt discloses that a presence availability server that detects a change in status of a user and then sends a notification to a notification server so that the notification server can inform a different user. Holt discloses that a presence availability server is configured to detect a change in presence or availability status of the user (see Abstract of Holt). The change is detected without a registrar server contacting the presence server. Holt does not disclose any type of separate registrar server. The presence notification server in Holt provides its own determination scheme to obtain status information.

Therefore, Holt does not disclose or suggest "sending a subscribe message for an event from the second network element to the first network element, wherein the event is a change in the registration information of at least one of the plurality of users...receiving

at the first network element a register message from at least one user, said message changing the registration information of said at least one user...sending a notification from the first network element to the second network element in response to the register message", as recited in claim 1 and similarly in independent claims 11, 17, 18 and 34-41.

Therefore, Applicants submit that Bobde and Holt, taken individually or in combination, fail to disclose all of the subject matter of independent claims 1, 11, 17, 18 and 34-41. By virtue of dependency, Bobde and Holt also fails to teach the subject matter of those claims dependent thereon. Withdrawal of the rejection of claims 1-7, 11-30 and 34-41 is kindly requested.

Claims 8, 9, 31 and 32 were rejected under 35 U.S.C. 103(a) as being unpatentable over Bobde in view of Holt and further in view of "IMPS – Instant Messaging and Presence using SIP" of Donovan ("Donovan"). The Office Action took the position that the combination of Bobde, Holt and Wang discloses all of the features of the claims except "wherein a third entity sends a subscribe message to the second entity for information associated with said at least one user. Applicants respectfully traverse this rejection.

Claims 8, 9, 31 and 32 depend respectively from, and further limit, claims 1 and 18. At least some of the deficiencies of Bobde and Holt with respect to claims 1 and 18 are discussed above. Donovan does not remedy the above-discussed deficiencies of Bobde and Holt, and, thus, the combination of Bobde, Holt, and Donovan fails to disclose or suggest all of the elements of any of the presently pending claims.

Donovan generally relates to Instant Messaging and Presence using SIP (IMPS), and was not cited with regard to the above-discussed features with respect to which the combination of Bobde and Holt is deficient. Donovan fails to remedy the above-identified deficiencies of Bobde and Holt because Donovan also fails to disclose "sending a subscribe message for an event from the second network element to the first network element, wherein the event is a change in the registration information of at least one of the plurality of users...receiving at the first network element a register message from at least one user, said message changing the registration information of said at least one user...sending a notification from the first network element to the second network element in response to the register message", as recited in claim 1 and similarly in independent claims 11, 17, 18 and 34-41. Accordingly, it is respectfully submitted that the combination of Bobde, Holt and Donovan fails to disclose or suggest all of the elements of claims 8-9 and 31-32, and withdrawal of the rejection is respectfully requested.

For the reasons set forth above, it is respectfully submitted that each of claims 1-44 recites subject matter that is neither disclosed nor suggested in the cited art. It is, therefore, respectfully requested that all of claims 1-44 be allowed, and that this application be passed to issuance.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by

telephone, the applicants' undersigned representative at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, the applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,

Kamran Emdadi
Registration No. 58,823

Customer No. 32294
SQUIRE, SANDERS & DEMPSEY LLP
14TH Floor
8000 Towers Crescent Drive
Vienna, Virginia 22182-6212
Telephone: 703-720-7800
Fax: 703-720-7802

KE:sjm